

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

REMARKS

Responsive to the Office Action dated July 18, 2005, the claims have been amended to clarify the nature of the invention. In particular, Claim 1 has been amended to distinguish the nature of the invention further from the disclosure of the cited prior art, in that it now relates to a **sports playing surface** *per se* rather than a mat that is suitable for such.

Claim 8 has been cancelled with the filler material of a “fibrous material” being added to Claim 7. Claim 7 also previously included other fibrous material such as peat, moss, wood chips, wood shavings, wood shavings, and so forth. Therefore, this is the same species as the other elements in Claim 7 and should not be deemed a separate invention since various types of fibrous material were already present and existing in this Claim. Applicant is respectfully believed to be entitled to this claim protection.

Claim 10 is now amended to delete the step of “heating or drying the mixture.” Therefore, the arguments presented by the Examiner regarding the necessity of searching this particular feature are rendered moot. Therefore, Claim 10 is merely the only method to create Claim 1 and is not a separate invention. It is respectfully requested that Claim 10 not be withdrawn from the Claims pending in this case. Claim 12 is now added as a dependent claim to Claim 10 to recite the heating or drying step. Since Claim 10 is merely the method of making Claim 1 and if an independent claim is nonobvious under 35 U.S.C. Section 103, then any claim depending therefrom is nonobvious, then there is no need for another patent search and Claim 12 is not a separate invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

35 U.S.C. Section 112:

Claims 1, 3-8, 9 and 11 were rejected under 35 U.S.C. Section 112, second paragraph, for failing to particularly point out and distinctly claim the subjection matter which Applicant regards as the invention. In particular, it was believed that there was an inconsistency between the uniform admixing of the support matrix and the filler material in Claim 1 and the use of close-packed tubes for the support matrix in Claim 3.

Claims 3 to 6 are hereby cancelled without prejudice. Claim 2 was cancelled in the previous filed response. These claims related to the tubes mentioned in the Examiner's rejection under U.S.C. Section 112. This removes from the scope of Claim 1 any ambiguity or inconsistency between the uniform mixing in Claim 1 and the tubes in Claim 3, and overcomes the rejection under U.S.C. Section 112. This amendment is to expedite prosecution only and is not for any reasons of patentability. The Applicant waives no rights with regard to these cancelled Claims.

Therefore, the rejection of Claims 1, 3-8, 9 and 11 under 35 U.S.C. Section 112 is respectfully believed to be overcome.

35 U.S.C. Section 103:

Claim 1 was rejected under 35 U.S.C. Section 103 over Besing (U.S. Patent No. 5,274,951) in view of Loads (U.S. Patent No. 4,099,345). The invention now claimed in the amended Claim 1 is a sports playing surface. This amendment draws the field of the invention

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

further away from the cited prior art of Besing and Loads, which relate to seed growth systems for horticultural use. Different considerations apply to the art of growing turf for horticultural purposes as opposed to making a sports mat, which does not even require the presence of grass. For example, the horticultural systems of the prior art documents focus entirely on keeping the grass seeds in prime conditions for growth, as the only objective of these systems is to deliver or grow the grass, and if they do not accomplish that, then nothing else they do will be of any consequence. In contrast, the objective of the sports mat, as discussed in Paragraphs [0005]-[0007] of the Applicant's Patent Application, is to mitigate the issues of player injuries, limited ball strikes, and playing positions, and so forth. Therefore, the Applicant argues that regardless of the disclosure of Besing and Loads, neither of them discloses or suggests anything concerning sports mats, and are therefore not relevant to the present invention as now claimed. The Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992). In this case, the prior art is not in the field of sports mats and is for growing grass, which is not at all pertinent for the problem of preventing sports injuries.

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

Besing (the primary reference) principally relates to the delivery of viable grass seeds to a *large* surface area of ground (verges beside highways are mentioned as one example). The “waffle” described by Besing for delivery of the seeds is not itself the primary product, and is only there to protect and deliver the seed, which is the whole *raison d’etre* of the Besing system. In order to do this cost effectively (one of the purported benefits of Besing’s seed delivery device mentioned in Column 1) it needs to be a very simple device. The Besing waffle therefore always needs to be: simple to facilitate low production costs; light to facilitate low transport and handling costs; and easily cut or broken to enable it to fit the desired shape *in situ* as shown in Fig 5. All of these considerations are rather inconsistent with the objectives of the present invention, where the mat is typically intensively designed for a **small area** of the overall surface, e.g., located at the striking position of the overall surface, with a **defined shape** requiring no cutting on site, and where the consistency of the mat has to be very tightly controlled to deal with the issues of player injury, resilience of the surface, and behavior of the ball, etc., when struck from the mat. These issues of most concern to the present invention dictate that the mat of the invention needs to be more “designed” than the Besing waffle, which is in a different league, and which offers no incentive for improvement for the skilled person seeking a better sports mat. In determining the differences between the prior art and the claims, the question under 35 U.S.C. Section 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

U.S.P.Q. 698 (Fed. Cir. 1983).

In fact, the Besing waffle is intentionally designed to mulch into the soil after the seeds have been delivered, and it would clearly be pointless to give the Besing waffle *more* structure or rigidity to increase its life, which would counteract this stated intention to dissolve into the soil as soon as the seeds have taken hold. Therefore Besing is “teaching away,” which is a well established justification for patentability. In determining the differences between the prior art and the claims, the question under 35 U.S.C. Section 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Thus a few minutes of consideration would leave no doubt in the mind of a moderately skilled person in the art that the Besing waffle as taught in the primary reference would not enable the production of a satisfactory golf practice mat (for example) because it is not durable enough. The Besing waffle is essentially an inexpensive paper-maché sheet, which is stiff enough to maintain its shape when being lifted or cut. However, it is neither strong nor resilient (it is deliberately intended and adapted to be broken or cut by hand – see Fig. 5) so after the first few strikes that it receives during golf practice, for example, it will split, rendering further play impossible.

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

The objection raised is premised on the basis that the skilled person would adapt the waffle of Besing to include the filler of sand as described in Loads **to increase its strength and durability**, and thereby arrive at the present invention. However, sand would not be added to the Besing recipe for the following reasons. Adding sand as suggested would complicate Besing's production process, which would be unable then to vacuum form the waffle as mentioned in Column 2, Line 65. Also, the sand would dramatically increase the weight of the waffle, which would affect the delivery and handling costs, which (according to the first column of Besing) dictate so much of the process and structure of the waffle. Also, adding sand to the paper-maché as suggested would destroy the stiff "egg-box" like consistency of the Besing waffle, and would mean that it could not be handled or transported without some kind of supporting box or tray etc. to stop it from bending. Finally, the addition of sand or any other structural element to the Besing waffle would likely increase the longevity of the various components in the soil after wetting, contrary to Besing's intention that the delivery components should dissolve as soon as the grass seeds have taken hold. Sand in the body of the waffle would also change the composition of the soil, and could adversely affect the ability of the grass seeds to germinate and take hold. Since the delivery and propagation of the *grass seeds* is the primary concern of Besing, this would be a significant disincentive to the skilled person tempted to add sand to the Besing waffle.

Second Amendment
Application No. 10/006,017
Amendment dated November 17, 2005
Reply to Office Action of July 18, 2005
Attorney Docket No. 41759-57630

It is also clear from the above analysis that if one were tempted to use sand with the Besing design it would be much more likely that it would be added as a separate component spread in the desired quantities *over* the body of the waffle after it was laid. That would allow the sand to fill within the apertures 2 in the waffle, which would level out the surface, and anchor the waffle more securely to the ground (a consideration that is in keeping with Besing's own remarks in Column 2, Lines 9-12). It would also be much more simple to transport the sand as a separate component and to sprinkle it over the already-laid waffle rather than modify the production process to incorporate sand within the body of the waffle as suggested by the Examiner. In fact, it is to be noted that the Besing design *advocates* the compartmentalizing of the various components of the seeds, glue and paper-maché waffle. This is also in contrast to the feature in the present invention of the uniform admixture of the support matrix and the filler. Finally, adding sand to the body of the Besing waffle would mean that the ratio of sand to seeds was fixed for the waffle. This would be a disadvantage in sandy soils where the waffle was to be used, because the overall ratio of sand/seed/soil might deny the grass seeds the proper growing conditions if the soil ended up too sandy as a result of the sand content in the body of the waffle. For this reason, the skilled person in the art would only add sand *as a separate component* so that the final ratio of the sand/seeds/soil in the location of use could be controlled by adding the correct amount of sand after the waffle had been laid.

Therefore, for the above reasons, assuming that a person of ordinary skill in the art were to consult Besing as a prelude to constructing a sports mat (which is not accepted, as argued

Second Amendment

Application No. 10/006,017

Amendment dated November 17, 2005

Reply to Office Action of July 18, 2005

Attorney Docket No. 41759-57630

above) that skilled person would not, even with knowledge of Loads, combine sand as a filler with the paper-maché as suggested by the Examiner, and would certainly not mix these components as a uniform admixture as claimed. Therefore, for the above reasons, the rejection under 35 U.S.C. Section 103 raised by the Examiner is respectfully traversed.

It is therefore submitted that the present Claim 1, as currently amended, is allowable and overcomes the rejection under 35 U.S.C. Section 103. Also, since Claim 10, as currently amended, is the method for making the product of Claim 1, with no additional limitations, it is respectfully believed that Claim 10 overcomes the rejection under 35 U.S.C. Section 103 in the same manner as Claim 1 and is in condition for allowance.

Moreover, Claims 3-8, 9 and 11 were also rejected under 35 U.S.C. Section 103 over Besing (U.S. Patent No. 5,274,951) in view of Loads (U.S. Patent No. 4,099,345). Claims 2-6 and 8 are hereby cancelled and it is respectfully believed that this rejection with respect to Claims 2-6 and 8 is rendered moot. Since Claims 7, 9, and 11 depend from and contain all of the limitations of Claim 1, as amended, Claims 7, 9, and 11 are felt to distinguish over Besing in view of Loads in the same manner as Claim 1. Therefore, Claims 7, 9, and 11 overcome the rejection under 35 U.S.C. Section 103.

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance

Second Amendment

Application No. 10/006,017

Amendment dated November 17, 2005

Reply to Office Action of July 18, 2005

Attorney Docket No. 41759-57630

this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

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